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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,110	03/29/2004	John W. Carter	GEN10 P-452	1535

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PRICE, HENEVELD, COOPER, DEWITT, & LITTON,
LLP/GENTEX CORPORATION
695 KENMOOR, S.E.
P O BOX 2567
GRAND RAPIDS, MI 49501

EXAMINER

AMARI, ALESSANDRO V

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/812,110

Applicant(s)

CARTER ET AL.

Examiner

Alessandro V. Amari

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-96 is/are pending in the application.
4a) Of the above claim(s) 5-20, 25-40, 42-50, 52-60 and 64-96 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4, 21-24, 41, 51 and 61-63 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/21/04; 11/28/05.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, subgroup a in the reply filed on 23 November 2005 is acknowledged.

The traversal is on the ground(s) that the restriction between Groups I and II is improper because one of the independent claims 41 simply recites that the term "forming" which would include the process of "injection molding" which was cited in the restriction as being the materially different process to make the mirror assembly. Further, the Applicant asserts that the Examiner has "sidestepped" this issue by stating that claim 51 (which recites "thixoforming") is not patentably distinct from claim 41.

In response to this traversal, the Examiner would like to point out that the Applicant failed to address claim 1 (the other independent claim) which does recite thixoforming. Further, claim 51 is dependent on claim 41 and both are part of the separate invention under Group I, i.e., the process of making the mirror assembly and as such is distinct from the invention of Group II.

The Applicant further argues that an independent claim cannot be considered a combination relative to a "subcombination" claim that depends from that independent claim and that claim 1 is readable on all its dependent claims and is generic to all claims. Therefore, the applicant asserts that claims 2-40 are all species disclosed under a claimed genus and related and accordingly, the requirements for election of species must also be applied. The Applicant further argues that since the Examiner

failed to apply the criteria for election of species and because the criteria would not apply in this instance, the restriction requirement is improper.

In response to this argument, the Applicant should note claim 1 is a linking claim linking related inventions and is not a genus claim linking species inventions. Applicant is reminded that claims are definitions of inventions and that claims are never species. See MPEP 806.04(e). Species are always specifically different embodiments. In this case, the related inventions are disclosed as subcombinations usable together (i.e., can be used without the particulars of the other subcombination), not specifically different embodiments. Therefore, the criteria for election of species would not apply in this instance.

The Applicant further argues that the subgroups set forth in the Office Action are not subcombinations that are disclosed as usable together in a single combination. The Applicant argues that claims 2, 5 and 7 are dependent claims which include all of the limitations of the claim incorporated by reference and if claims 2, 5, and 7 each define a subcombination, the subcombinations combined together in a single combination would include for example, three plate covers, three mounts, three pivot balls and three mirrors.

In response to this argument, the Applicant is reminded that the inventions are related as subcombinations useable together because the subcombinations are **disclosed** as useable together in a single combination that is, it can be used without the particulars of the other subcombinations (i.e., separate utility). This disclosure is shown in the claim structure. For example, claim 2 (reciting components thickness details)

does not rely on the particulars or details of the other claims such as claim 5 (reciting plate frame details) or claim 7 (reciting cover details). Each of these claims while dependent on the linking claim (claim 1) defines a separately useable subcombination. The restriction requirement provided evidence for each and every subcombination having separate utility. The Applicant provided no argument supported by facts that the other use suggested by the Examiner cannot be accomplished or is not reasonable and therefore the restriction requirement is maintained. See MPEP 806.05(d).

The requirement is still deemed proper and is therefore made FINAL.

Therefore, claims 5-20, 25-40, 42-50, 52-60 and 64-96 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 21-24, 41, 51 and 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skiver et al US 6,329,925 in view of Ohshita et al US 2003/0213771.

In regard to claim 1, Skiver et al teaches (see Figures 1-3, 5, 6) a method of making an interior rearview mirror assembly comprising providing interior rearview mirror components, the components comprising a plate frame (18), a cover (12), a

mount (24 or 32) and a pivot ball (26); providing a mirror (14); assembling the interior rearview mirror components and the mirror to form the interior rearview mirror assembly as shown in Figure 2.

In regard to claim 41, Skiver et al teaches (see Figures 1-3, 5, 6) a method of making an interior rearview mirror assembly comprising providing interior rearview mirror components, the components comprising a plate frame (18) and a cover (12), providing a mirror (14); assembling the interior rearview mirror components and the mirror to form the interior rearview mirror assembly as shown in Figure 2.

However, in regard to claims 1, 41 and 51, Shiver does not teach thixo-forming or thixomolding at least one of the components from a material comprising magnesium or that at least one of the components is from a material comprising magnesium.

In regard to claims 1, 41 and 51, Ohshita et al teaches thixo-forming or thixomolding at least one of the components from a material comprising magnesium as described on page 1, paragraph 0005.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the magnesium of Ohshita et al in the making of the mirror of Skiver et al in order to provide a lighter weight alternative to other metals while still providing superior strength as well as excellent recycling capabilities. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the casting method of thixoforming magnesium components as taught by Ohshita et al in the making of the mirror of Skiver et al in order to provide for superior dimensional accuracy and productivity of the components.

Further regarding claims 2, 21, 22 and 61, Skiver et al in view of Ohshita et al teaches the invention as set forth above and in regard to claim 21, teaches an interior rearview mirror assembly made from the method of claim 1 as shown in Figure 1 and teaches (see Figures 1-3, 5, 6) that at least one of the components includes a wall (this can be either the wall of cover 12 as shown in Figure 3 or the wall comprising the plate 18 as shown in Figure 6 or the wall included in the mount 24 as shown in Figure 5).

However, in regard to claims 2, 22 and 61, Skiver et al in view of Ohshita et al does not teach that the wall has a thickness of less than about 0.75mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust the thickness of the wall to be less than 0.75mm, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. One would have been motivated to adjust the thickness of the wall of Skiver et al in view of Ohshita et al for the purpose of producing a lighter weight and more compact mirror assembly thus reducing costs. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) It should also be noted that the Applicant did not indicate the criticality of the thickness being less than .75mm in the disclosure.

Regarding claims 3, 23 and 62, Skiver et al in view of Ohshita et al teaches (see Figures 1-3) that at least one of the components includes the wall comprises the cover (the wall of cover 12 as shown in cross-section in Figure 3).

Regarding claims 4, 24 and 63, Skiver et al in view of Ohshita et al teaches (see Figures 1-3, 5) that at least one of the components includes the wall comprises the mount (the wall included in the mount 24 as shown in cross-section in Figure 5).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alessandro V. Amari whose telephone number is (571) 272-2306. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ava/vh
19 January 2006

Alessandro V Amari
Alessandro V Amari
Examiner AV2872